

Comments On-Interim Guidelines For Examination Of Patent Applications Under The 35 U.S.C. § 112, ¶ 1 "Written Description" Requirement

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Summary

The Interim Guidelines appear to entirely overlook the "omitted element" prong of the written description requirement. Although a patent claim normally may be broader than the patent application's disclosed embodiments, a patent claim may not be broader than the disclosed invention. For this reason, a patent claim may not omit anything described in the written description as being a non-optional element of the invention. That has been the law for at least one hundred years. The Interim Guidelines, however, have either overlooked this well-established prong of the "written description" requirement, or at least confused it with its better known cousin that prohibits adding to a patent claim something not disclosed in the original application. It is suggested that the Guidelines be corrected to address this prong of Section 112, ¶ 1.

The Two Prongs Of The Written Description Requirement

There are two basic ways for a patent claim to illegally deviate from the written description in the original patent application. First, the invalid claim might recite an element that was not clearly disclosed in the original application. In this first ("added element") prong, the claim is not "supported by" the written description because it does not "read on" the written description.² Second, an invalid claim might illegally omit an element of the invention described in the original application. In this second prong, each claim element may be fully disclosed in the original application, but the claim still is invalid because it omits part of the described invention. Under each prong, the claim is invalid because it covers something different or broader than the invention described in the original application. The only difference is that the impermissible broadening is achieved by omitting elements of the invention as originally described.

The Omitted Element Prong

It has long been a fundamental and fatal defect for a U.S. patent claim to omit any element of the described invention. See U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 671, 677-78, 86 L. Ed. 1105, 1110, 1112-13 (1942) (where an "object" of the invention and all examples disclosed in the original application included water as one of the elements of the invention, reissue patent claims omitting water as an element were held invalid)³; Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 55, 83 L. Ed. 34, 38

(1938) (where a "rigid" support was a stated "object of the invention," claims lacking that limitation and instead reciting yieldable support, were held invalid); Olin v. Timken, 155 U.S. 141, 146-47, 39 L. Ed. 100, 102-03 (1894) (where the patent application described as an invention a set of springs on a buggy or wagon with a bolt connecting the two springs, reissue claims omitting the bolt were held invalid); Huber v. Nelson Mfg. Co., 148 U.S. 270, 291-92, 37 L. Ed. 447, 454 (1893) (where the original patent on a water closet had referred to the "flushing chamber" 31 times and the entire text and drawings included a flushing chamber as part of the invention, reissue claims omitting that element were held invalid); Matthews v. Machine Co., 105 U.S. 54, 26 L. Ed. 1022 (1881) (where the "subject of the original invention," namely a hydrant casing whose top was covered by a flange projecting from the hydrant, was omitted from reissue patent claims, the claims were invalid because they were not for the same invention as originally described); In re Sus, 306 F.2d 494, 495, 504 (C.C.P.A. 1962) (where claims omitted a limitation that had appeared within the application's "object of the invention" statement, they were held invalid under Section 112, ¶ 1); In re Simon, 302 F.2d 737 (C.C.P.A. 1962) (where the application had disclosed that a composition included ingredients A + B + C + D + E, patent claims that omitted elements D + E were held invalid).

As noted above, this omitted element prong should not be confused with its more popular cousin, the added element prong. In the seven omitted element authorities cited above, the claims were invalid even though they most likely "read on" the original disclosure. For example, in In re Simon, 302 F.2d 737 (C.C.P.A. 1962), the claims recited elements A, B, and C, and each of those elements was disclosed in the application's disclosure. The claims "read on" the disclosure because no elements were added to the claims that were missing from the disclosure. That, however, did not save the claims, because the issue was not whether the claims "read on" the disclosure. The claims were invalid not because they added a feature that was absent from the original application, but because their limitations omitted a feature that was part of the invention disclosed in the original application.

The Recent Prosthesis And Sofa Cases

This long-established legal principle is still good law. Tronzo v. BioMet, Inc., ___ F.3d ___ (Fed. Cir. Aug. 28, 1998); Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473 (Fed. Cir. 1998).

Tronzo concerned artificial hip sockets that include a cup implant for insertion into a hip bone. The apparatus claims in question issued from a CIP application. The PTO had confirmed the patentability of these claims in two reexaminations. The parties stipulated that if those CIP claims were not entitled to

the parent's filing date, then they would be anticipated by the publication of the parent application's British counterpart.

The challenged claims recited various features of the cup but did not specify the shape of its outer surface. The written description described two species of cups, both of which had a truncated conical shape. The written description referred to other shapes, but only in discussing the prior art. According to the Federal Circuit, the specification "specifically distinguishes the prior art as inferior and touts the advantages of the conical shape" of the patent's cup. The Court concluded that:

Such statements make clear that the '589 patent discloses only conical shaped cups and nothing broader. The disclosure in the '589 specification, therefore, does not support the later-claimed generic subject matter in [the challenged] claims.

In other words, the parent application's written description described the truncated conical shape as being part of the invention, so the omission of this non-optional element of the invention invalidated the claims.

In Gentry Gallery, the Federal Circuit reversed, as clearly erroneous, a finding that certain asserted patent claims satisfied the written description requirement. The patent described a sectional sofa having two independent reclining seats ("recliners"). Previously, such recliners had their adjustment controls on their arms. In an L-shaped configuration of a sectional sofa, therefore, the recliners had to be on opposite ends of the sofa so that their controls would be accessible. This "prior art" arrangement, according to the patent, was "not comfortable or conducive to intimate conversation." 134 F.3d at 1475.

The Court of Appeals summarized the invention of the original patent application as follows:

The invention of the patent solved this supposed dilemma by, inter alia, placing a 'console' between the two recliners which face in the same direction. This console 'accommodates the controls for both reclining seats,' thus eliminating the need to position each recliner at an exposed end of a linear section. Accordingly, both recliners can then be located on the same linear section allowing two people to recline while watching television and facing in the same direction.

Id. (citation to patent omitted). The issue was whether the placement of the controls on the console was an element of the invention described in the original

application. To answer that, the Court looked initially to the Objects of the Invention. One of the objects of the invention was “to provide . . . a console positioned between [reclining seats] that accommodates the controls for both of the reclining seats.” Id. at 1479. From this quoted Object of the Invention, the Court of Appeals concluded that “thus, locating the controls anywhere but on the console is outside the stated purpose of the invention.” Id.

The Gentry Gallery Court also looked to the scope of the claims that were submitted with the original application to see how they defined the “invention.” It found that even the “broadest original claim” was directed to a sofa having a control means located on the console. Id.

The Court also noted that the patent application had disclosed alternative locations for the exact placement of the controls, but that none of these alternatives moved the controls beyond the console itself. Id. Based on this evidence, and testimony of the named inventor, the Court concluded that “when viewed in its entirety, the disclosure is limited to sofas in which the recliner control is located on the console.” Id. In other words, this feature was an “essential element” of the described invention. Id.

When the patent issued, however, it contained some broad claims “in which the location of the controls is not limited to the console.” Id. at 1476. The patent owner tried to defend these broad claims by citing case law that a patent need disclose only one embodiment of the invention. The Federal Circuit disagreed and held the claims invalid under 35 U.S.C. § 112, ¶ 1. Id. at 1479-80. The Court cited its earlier precedent that a patent applicant may exclude from a claim a particular feature described in a patent only if that feature was not an element of the invention. Id. at 1479. “Here, as indicated above, it is clear that [the patent applicant] considered the location of the recliner controls on the console to be an essential element of his invention. Accordingly, his original disclosure serves to limit the permissible breadth of his later-drafted claims.” Id. “[C]laims may be no broader than the supporting disclosure, and therefore [a] narrow disclosure will limit claim breadth.” Id. at 1480. Consequently, it was clearly erroneous to find that the patent owner was entitled to claims in which the recliner controls need not be located on the console. Id.

In summary, Section 112, ¶ 1, requires a simple comparison between a patent claim’s limitations and a patent application’s invention elements. If the claim’s limitations (which define the “claimed invention”) omit any element of the originally disclosed invention, then the claim is invalid for being broader than the disclosed invention. For example, in Gentry Gallery, the claimed invention was broader than the disclosed invention because the challenged patent claims omitted the limitation that the controls be placed on the console, which was an element of the invention described in the application.

This Gentry Gallery decision, which follows the long-established omitted element prong, has been criticized as supposedly being inconsistent with the doctrine that patent claims normally need not be limited to the disclosed embodiments.⁴ As the Gentry Gallery court expressly recognized, however, “a claim need not be limited to a preferred embodiment” 134 F.3d at 1479, but “may be no broader than the supporting disclosure,” *id.* at 1480. This crucial distinction between “preferred embodiment,” “disclosed invention,” and “claimed subject matter,” is at the heart of the written description requirement.

The Interim Guidelines Appear To Overlook This “Omitted Element” Prong

The “Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112 ¶ 1 ‘Written Description’ Requirement.” 63 Federal Register 32639-32645 (June 15, 1998), address the “written description” requirement in depth, but do not even mention this omitted element branch or cite any of the nine “omitted element” cases discussed above.

As a result of overlooking this issue, the Guidelines contain several sweeping statements that appear contrary to law. For example, in section D(1) the guidelines state that if a “representative number” of species have been disclosed, then a written description rejection “must not be made.” That is not always so. If all of the disclosed species include some feature that is described as a non-optional element of the invention, then a genus claim lacking that element must be rejected.

Generally speaking, the Guidelines’ methodology is geared only toward the “added element” prong of the written description requirement, and ignores the “omitted element” prong. It is respectfully suggested that the PTO add a separate section to the Guidelines that deals with this issue and summarizes at least some of the nine omitted element cases cited above.

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This is a personal submission of the author and does not necessarily reflect the views of Klarquist, Sparkman, Campbell, Leigh & Winston, LLP or of any client of the firm.

² The issue is not whether the claims would be an obvious extension of the original application's "invention." See Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 58-59, 83 L. Ed. 34, 39-40 (1938) (rejecting claims reciting that a certain member was laterally flexible, even though those skilled in the art may have known that a laterally flexible member would have worked better, because "that was not the invention which [the applicant] described by his references to an extremely rigid [member] "); U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 671, 678, 86 L. Ed. 1105, 1110, 1112-13 (1942) (dismissing expert testimony that the omitted element (water) was so immaterial that the same results were obtained without it, because original patent disclosure did not say that). In Lockwood, addressing an "added elements" violation of the written description requirement, the Federal Circuit affirmed summary judgment of patent invalidity. The patent owner had argued that its later-claimed subject matter would have been obvious in view of the originally disclosed invention. The Federal Circuit rejected that argument, holding that "[e]ntitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed." 107 F.3d at 1571-72.

³ See In re Amos, 953 F.2d 613, 618 (Fed. Cir. 1991) ("the inquiry under [reissue provision] § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112, ¶ 1.").

⁴ See L.H. Pretty, "The Recline and Fall of Mechanical Genus Claim Scope Under 'Written Description' in the Sofa Case," 80 J.P.T.O.S. 469 (July 1998).